

### REMARKS

The Applicants respectfully request reconsideration and allowance of Claims 1, 3-14, 16-22, 24-29, and 38-42 in view of the following arguments.

The Applicants also respectfully request that the above amendments to the disclosure be entered to correct typographical errors in the disclosure at pages 1 and 3.

### THE CLAIMS ARE NOT OBVIOUS OVER SCHNEIER IN VIEW OF NOVAK

The Examiner rejected Claims 1, 3-14, 16-22, and 24-29, and 38-42 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,871,398 to Schneier et al. (the "Schneier patent" or "Schneier") in view of U.S. Patent No. 5,239,165 to Novak (the "Novak patent" or "Novak"). The Applicants respectfully traverse these rejections on the ground that the proposed combination does not teach or suggest each and every limitation set forth in the claims and on the ground that there is no teaching, suggestion, or motivation in the prior art to make the combination proposed by the Examiner.

#### The Schneier Patent

The Schneier patent discloses a system in which a player purchases a number of predetermined game outcomes which are used in games at a specific remote player terminal or HTV. The outcomes are transferred to the HTV in the form of an authenticatable game authorization message or AGAM. The AGAM may be transferred in a number of different forms such as by hard wire or wireless communications, by manual entry, by voice entry, or by some data carrier such as a smart card. In forms of the Schneier system in which the AGAM is manually entered at an HTV, the AGAM is first printed on a paper receipt at a retail location and

the player then manually reads the printed AGAM and enters it into the HTV in some fashion.

Where a data carrier is used to transfer the AGAM to the HTV, the HTV includes a reader capable of reading the data making up the AGAM from the data carrier. AGAM creation is discussed in the Schneier patent particularly beginning at Col. 9, line 57 through Col. 11, line 22. The manner of communicating the AGAM to the HTV is described in Schneier beginning at Col. 13, line 61 through Col. 14, line 32.

#### The Novak Patent

The Novak patent is directed to a lotto-type lottery system that is particularly adapted to be used in supermarkets or other stores having multiple check stands. The lotto-type lottery system includes a pick stand 14 at which a player may pick their lotto numbers, and a respective lottery device black box 16 and lottery ticket printer 32 located at each check stand 13 at the given store. Generally, a player picks their lotto numbers at the pick stand 14 and obtains a pick ticket with a bar code that is correlated to the player's lotto number selections in a data storage device accessible by each store black box 16. The player may take their pick ticket to a check stand 13 and have their pick ticket bar code scanned in using the check stand scanner. The black box 16 then uses the detected bar code to obtain the player's lotto number picks and communicates with a central lotto computer at a remote location to give the central computer the player's picks and obtain a serial number from the central computer. The lottery ticket printer 32 at the respective check stand prints a lotto ticket for the player including the player's lotto number picks for each entry in the lotto game, a bar code including the lotto ticket serial number, and the date.

It is important to note that the type of lottery game described in the Novak patent is an entirely different type of game than the pre-determined outcome games described in the Schneier patent and claimed in the present claims. Rather than a pre-determined outcome lottery game, Novak discloses a lotto type lottery game in which players pick lotto numbers and later compare their selected numbers with numbers randomly drawn by the lottery authority some time after the lotto ticket purchase. Because it describes a lotto-type lottery game, Novak does not disclose any stored game records each associated with a game play outcome, nor does it teach or suggest printing ticket indicia on any ticket where each ticket indicia represents the respective game play outcome associated with a particular one of the stored game records. Novak discloses only printing lotto number selections on the lotto ticket which are later compared with a lottery draw to determine if the lotto number selections win a prize.

#### Claim 1

Applicants' claim 1 requires a process in which a game ticket is created in response to a ticket request from a player. In particular, element (d) of claim 1 requires applying a number of ticket indicia to a ticket substrate to produce the game ticket. Each ticket indicia must be directly identifiable and corresponds to a particular one of the game records so as to represent the respective game play outcome associated with the particular one of the game records. Element (e) of claim 1 further requires applying machine readable game play information to the ticket substrate. This game play information specifies each game play outcome represented on the game ticket. It is noted that according to claim 1, each directly identifiable ticket indicia represents the respective game play outcome associated the corresponding stored game record.

That is, the ticket indicia represents a game play outcome at the time it is printed, not at some later time.

The Examiner concedes that the Schneier patent does not teach or suggest printing a number of identifiable ticket indicia to the ticket substrate. To make out the rejection of claim 1 set out in the outstanding Office Action, the Examiner cites the Novak patent as disclosing a printer applying a number of ticket indicia to a ticket substrate to produce a lottery ticket. (Office Action, page 3, lines 5-6). However, element (d) of claim 1 does not merely require printing ticket indicia to a ticket substrate. Rather, element (d) of claim 1 requires a particular relationship between the printed indicia and the stored game records and their associated outcomes. In particular, element (d) of claim 1 describes each ticket indicia as "being directly identifiable, corresponding to a particular one of the game records, and representing the respective game play outcome associated with the particular one of the game records." Thus, even if the printed indicia taught by the lotto system of Novak are somehow combined with the pre-determined outcome lottery system of Schneier, the resulting combination still does not teach or suggest each and every element of claim 1. The currently outstanding Office Action fails to make out a prima facie case of obviousness as to claim 1 because the proposed combination does not teach or suggest each and every element required in the claim.

Because the Examiner's proposed combination of the Schneier patent and the Novak patent does not teach or suggest all of the elements set out in claim 1, the Applicants submit that claim 1 is entitled to allowance together with its dependent claims, claims 3 through 13.

Claims 14, 22, 30, and 34

Independent Claims 14 and 22 each include limitations similar to those set out in Claim 1, but in program product and system form, respectively. The Applicants submit that Claims 14 and 22 are entitled to allowance for the same reasons as set forth above with respect to Claim 1. The proposed combination of the Schneier patent and the Novak patent simply does not teach or suggest the method, program product, or system elements for applying both the required ticket indicia and the game play information on the ticket substrate in response to a ticket request from a player.

The Applicants therefore submit that Claims 14 and 22 are not obvious in view of the Schneier patent and the Novak patent and are entitled to allowance together with their respective dependent claims.

Claim 38

Independent claim 38 is directed to a gaming system utilizing a number of stored game records similar to the stored game records described in the other independent claims. The system includes a point of sale component for receiving a game ticket request and play quantity from a player, and a game ticket dispenser for applying a number of directly identifiable ticket indicia to produce a game ticket similar to that described in the other independent claims. Thus, claim 38 is allowable for the same reasons discussed above with reference to element (d) of claim 1.

The system of claim 38 also includes a ticket data storage device for storing a set of ticket data which is correlated to a ticket identifier and identifies each game record represented on the game ticket by the ticket indicia. Additionally, claim 38 requires at element (d):

a player terminal operatively connected for communication with the ticket data storage device, the player terminal for communicating ticket usage information to the ticket data storage device in response to each game play input entered by a player at the player terminal.

The Schneier Patent discloses remote player terminals or HTVs which do not maintain communications with any other part of the system during the course of play. Rather, the HTVs allow the player to remotely see the outcomes encoded into the AGAM transferred to the HTV, and then generate a redemption request message to enable players to cash out winnings. The Schneier patent certainly does not teach or suggest the player terminal required at element (d) of claim 38.

It is noted that in making the rejection of claims 38-42, the Examiner refers to Col. 11, lines 23-32 of the Schneier patent for the proposition of transferring ticket usage information to the central system (CMC) from the HTV in order to keep the player's account accurate. However, the cited passage in Schneier very clearly states that the accounting routine at the CMC is used to "track the cumulative value of player winnings and losses **after the player has cashed-out**" (emphasis added). This is in stark contrast to the requirement of element (d) of claim 38 for a player terminal for communicating ticket usage information to the ticket data storage device **in response to each game play input entered by a player at the player terminal.**

For these reasons, the Applicants submit that claim 38 is not obvious in view of the proposed combination of Schneier and Novak, and is entitled to allowance together with its dependent claims, claims 39 through 42.

THE PROPOSED COMBINATION OF SCHNEIER AND NOVAK IS IMPROPER UNDER 35 U.S.C. §103

In order to combine elements from different prior art references under 35 U.S.C. §103(a), there must be some teaching, suggestion, or motivation in the prior art to make the combination. In this case the Examiner has proposed to use the lotto ticket printer from the lotto ticket system of Novak in the pre-determined outcome lottery system disclosed in Schneier. However, there is no teaching, suggestion, or motivation in the prior art to combine a lotto ticket printer with a pre-determined outcome type lottery system.

To support the combination of the lotto ticket printer in Novak with the pre-determined outcome type lottery system in Schneier, the Examiner indicates at page 3, lines 6-7 of the Office Action that “[O]ne would be motivated to provide ticket-printing capabilities to Schneier in order to satisfy the needs of players that would prefer to play a real ticket game instead of a virtual ticket game.” However, the Schneier patent itself discloses a version of the system in which the AGAM is printed in some coded but human readable form on a physical ticket (Schneier at Col. 13, line 61 through Col. 14, line 12). In this printed ticket version of the Schneier system, the player manually inputs the AGAM code from the physical ticket into the HTV to see the outcomes associated with the AGAM. Thus, Schneier already satisfies the needs of players that would prefer to play a real ticket game instead of a virtual ticket game. There is no teaching, suggestion, or motivation in the prior art to displace the real ticket printing capabilities already disclosed in Schneier with any other ticket printing capabilities, and certainly not with the lotto ticket printing arrangement from the Novak patent.

For all of these reasons the Applicants respectfully submit that the proposed combination of the Schneier and Novak patents set out in the currently outstanding Office Action is improper under 35 U.S.C. §103(a). The Office Action fails to make out a prima facie case for obviousness as to the Applicants' claims on this ground as well as the ground that the proposed combination fails to teach or suggest each and every element set out in the claims.

### CONCLUSION

For all of the above reasons, the Applicants respectfully request reconsideration and allowance of claims 1, 3 through 14, 16 through 22, 24 through 29, and 38 through 42.

If the Examiner should feel that any issue remains as to the allowability of these claims, or that a conference might expedite allowance of the claims, he is asked to telephone the undersigned attorney.

Respectfully submitted,

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### CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, (Fax No. 703-872-9306) on March 18, 2004.

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